



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,222	06/27/2000	Marco A. DeMello	MSFT-0185	4140

7590 02/03/2004

Peter M Ullman
Woodcock Washburn Kurtz Mackiewicz & Norris LLP
One Liberty Place 46th Floor
Philadelphia, PA 19103

EXAMINER

VAUGHAN, MICHAEL R

ART UNIT	PAPER NUMBER
----------	--------------

2131

DATE MAILED: 02/03/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/604,222

Applicant(s)

DEMELLO ET AL.

Examiner

Michael R Vaughan

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-48 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4, 5
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Claims 1-48 have been examined and are pending.

Information Disclosure Statement

2. An initialed and dated copy of Applicant's IDS form 1449, Paper No. 4,5 and 9 is attached to the instant Office action.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because the length exceeds 150 words. Correction is required. See MPEP § 608.01(b).

Drawings

4. The drawings are objected to because Figures 3-6, 8, and 10 do not comply with CFR 1.84 (m). There is no need to shade the elements of Figures 3-6, 8, and 10 because they do not enhance the understanding of the invention. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC ' 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the

requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1-5, 7-31, 33-38, and 40-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Khan et al (USP 6,029,046).

As per claim 1, Khan et al teach:

receiving, from a computing device, a request to enable the use of said digital work on said computing device, said request comprising first data indicative of a user, said digital work being associated with said user and requiring the presence of second data on said computing device in order to be used on said computing device (column 15, line 23-38); and

if a limit associated with said user has not been reached, providing said second data to said computing device (Fig 7).

As per claim 16, Khan et al teach receiving, from a first computing device, a first request to activate said software installed on said first computing device, said request comprising information indicative of a user, said software having an activated state and a non-activated state (column 15, lines 23-38);

determining that an activation limit associated with said user has not been reached (Fig 7); and

providing first activation data to said first computing device (column 4 , line 26).

As per claim 27, Khan et al teach receiving, from a first computing device, a first request to activate first software installed on said first computing device with respect to a first user (column 15, lines 23-38);

determining that an activation limit associated with said first user has
15 not been reached (Fig 7); and

activating said first software with respect to said first user; wherein said first software renders at least a first class of digital works without regard to whether said first software has been activated, and a second class of digital works only if said first software has been activated with respect to said first user (column 1, lines 60-65).

As per claim 37, Khan et al teach receiving, from a first computing device, a first request to enable said enhanced feature on said first computing device (column 15, 23-38);

determining that a limit has not been reached (Fig 7);

enabling the use of said enhanced feature on said first computing device (Fig 7);

wherein said first computing device has at least some non-enhanced features usable regardless of whether said enhanced feature is enabled (column 1, lines 60-65), and wherein said limit is selected from the group consisting of. a restriction on the number of computing devices on which said enhanced feature may be enabled (column 2, line 19), and a restriction on the rate at which computing devices may be enabled to use said enhanced feature (column 2, line 17).

As per claim 42, Khan et al teach:

receiving said persona's credentials (column 2, line 18) (this teaching is inherent because Khan's system uses subscribers who must first provide credentials to the service in order to be billed accordingly);

authenticating said credentials by querying a namespace authority (Fig 1, elements 104 and 105);

requesting first information from the remote computing device (column 15, lines 23-38);

determining a number of activations of the software within a first period of time in accordance with the persona's credentials and first information requested from the remote computing device; and if the number of activations is less than a maximum number of activations within said first period of time (Fig 7), then:

generating an activation certificate that includes second information related to the persona's credentials (column 13, lines 41-46); and

uploading said activation certificate to the remote computing device to activate the software residing on the remote computing device such that operation of the software is associated with the persona's credentials (column 13, lines 25-30).

As per claim 2, Khan et al teach a restriction on the number of computing devices which said user may enable for use of said digital work (column 2, line 19 and column 14, lines 62-66).

As per claim 3, Khan et al teach a restriction on the rate at which said user might enable computing devices to use said digital work (column 2, line 17).

As per claim 4, Khan et al teach a first predetermined number of computing devices on which use of said digital work may be enabled during a first time period (column 14, lines 62-65 and column 7, lines 5-20); and

the product of a second number and a third number, wherein said second number is the number of second time periods that have commenced or elapsed since the end of said first time period, and said third number is a number of computing device on which use of said digital work may be enabled for each of said second time periods (column 15, lines 1-6).

As per claim 5, Khan et al teach time-dependent number is capped at a maximum value if said sum exceeds said maximum value (column 16, lines 56-57).

As per claims 7, 18, and 28, Khan et al teach said digital work comprises text, and wherein use of said digital work comprises displaying said text on one of said plural computing devices (column 4, lines 25-41).

As per claims 8, 19, and 29, Khan et al teach digital work comprises multimedia content, and wherein use of said digital work comprises rendering said multimedia content on one of said plural computing devices (column 4, lines 25-41).

As per claims 9, 20, and 30, Khan et al teach said multimedia content comprises music, video, animations, or pictures (column 4, lines 38-41).

As per claims 10 and 33, Khan et al teach said digital work is created subsequent to the provision of said second data to said computing device (column 15, lines 23-47).

As per claim 11, Khan et al teach said second data comprises a first cryptographic key, which enables use of said digital work (column 12, lines 1-11).

As per claims 12 and 45, Khan et al teach said second data further comprises a second cryptographic key, wherein said first and second cryptographic keys are the private and public keys, respectively, of an asymmetric key pair, wherein said digital work comprises encrypted content and a decryption key which decrypts said encrypted content, and wherein at least a portion of said second data including said second cryptographic key is uploadable to a content provider whereby said decryption key may be included in said digital work in a form 5 encrypted by said second cryptographic key (column 12, lines 1-11).

As per claim 13, Khan et al teach said second data comprises information indicative of said user (column 15, lines 26).

As per claims 14 and 46, Khan et al teach said first data is durably stored on said computing device so as to permit the enduring use of said digital work on said computing device (column 2, lines 50-60).

As per claim 15, Khan et al teach a computer-readable medium having computer executable instructions to perform the method of claim 1 (column 7, line 10).

As per claim 17, Khan et al teach wherein said software comprises content rendering software, wherein said software renders a first class of digital works without regard to whether it is in the activated state, and wherein said software renders a second class of digital works only when it is in the activated state (column 1, lines 60-65).

As per claims 21 and 47, Khan et al teach wherein said software in some manner processes a class of digital works, wherein each of said digital works in said class comprises encrypted content and a decryption key which decrypts said encrypted content, said decryption key being included in said digital work in an encrypted form

Art Unit: 2131

decryptable with a cryptographic key, and wherein said first activation data comprises said cryptographic key (column 12, lines 1-11).

As per claims 22 and 31, Khan et al teach receiving, from a second computing device, a second request to activate said software installed on said second computing device, said second request comprising information indicative of said user (column 20, lines 50-65 and Fig 7);

determining that said activation limit associated with said user has been reached (column 19, lines 1-4); and

denying activation of said software on said second computing device (Fig 7).

As per claim 23, Khan et al teach the act of providing a secure repository to said first computing device, said secure repository being in at least some way dependent upon said first computing device (column 2, lines 55-57).

As per claims 24 and 34, Khan et al teach activation limit comprises a restriction on the number of activations of said software that said user may request (column 2, line 20).

As per claims 25 and 35, Khan et al teach activation limit comprises a restriction on the rate at which said user may activate said software (column 2, line 16).

As per claim 26, Khan et al teach a computer-readable medium having computer-executable instructions to perform the method of claim 16 (column 7, line 10).

As per claim 36, Khan et al teach a computer-readable medium having computer-executable instructions to perform the method of claim 27 (column 7, line 10).

As per claim 38, Khan et al teach enhanced feature is associated with a user, wherein said limit is associated with said user, and wherein said first request comprises information indicative of said user (column 2, line 18).

As per claim 40, Khan et al teach enhanced feature comprises rendering a first class of digital works, and wherein said non-enhanced features comprise rendering a second class of digital works (column 1, lines 60-65).

As per claim 41, Khan et al teach a computer-readable medium having computer-executable instructions to perform the method of claim 37 (column 7, line 10).

As per claim 43, Khan et al teach the act of increasing said maximum number after the elapse of a second period of time (column 11, 53-62).

As per claim 44, Khan et al teach said software renders a first set of digital works without regard to whether said activation certificate is present on said remote computing device, and wherein said software renders a second set of digital works associated with said persona only if said activation certificate is present on said remote computing device (column 1, lines 60-65).

As per claim 48, Khan et al teach a computer-readable medium having computer-executable instructions to perform the method of claim 42 (column 7, line 10).

Claim Rejections - 35 USC ' 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the

subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Khan et al in view of Subbiah et al (USP 6,035,403).

As per claim 32, Khan et al fail to teach receiving, from said first computing device, a second request to activate said first software with respect to a second user. Subbiah et al teach receiving, from said first computing device, a second request to activate said first software with respect to a second user (column 5, lines 45-50). Khan et al teach a system in which certain features are geared towards enticing users to buy premium subscriptions to services (column 1, lines 60-65). Subbiah et al teach that one way to entice friends to purchase a product is to allow a user to let his/her friend install a limited version of the purchased product in hopes that the product will win over the favor of the friend (column 1, lines 40-45).

In view of this, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teaching of Subbiah et al within the system of Khan et al because it would allow the system to possibly attract new subscribers and hence make more profit.

Khan et al teach determining that an activation limit associated with said second user has not been reached; and activating said first software with respect to said second user; wherein said first software further renders a third class of digital works only if said first software has been activated with respect to said second user (Fig 7).

7. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Khan et al in view of White et al (USP 5,983,273).

As per claim 39, Khan et al teaches that users must subscribe to the service (column 2, lines 16). Khan et al are silent in expressly disclosing information comprises a username and password, and wherein said method further comprises the act of querying a namespace authority to validate said username and password. White et al teach information comprises a username and password, and wherein said method further comprises the act of querying a namespace authority to validate said username and password (column 7, lines 43-50). A username password match as taught by White et al is a well-known secure manner of authentication.

In view of this, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teaching of White et al within the system of Khan et al because it would allow the system to securely recognize a subscriber and thereby deter rogues from stealing valid subscriptions.

Claim Objections

8. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R Vaughan whose telephone number is 703-305-0354. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MV
Michael R Vaughan
Examiner
Art Unit 2131


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100